

REMARKS

In the Official Action mailed on **25 January 2006**, the Examiner reviewed claims 1-15 and 17-21. Claims 1-15 and 17-21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Primis ("Primis Custom Publishing, web pages describing product features, dated circa 1998, Pages 1-12," hereinafter "Primis").

Rejections under 35 U.S.C. 35 U.S.C. §103(a)

Independent claims 1, 14, 15, and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Primis. Applicant respectfully points out that in order to establish a prima facie case of obviousness, all claim limitations must be taught or suggested by the prior art. MPEP § 2143.03. Applicant respectfully notes that not all of the claim limitations are taught or suggested by the cited prior art. In fact, several significant claim limitations are missing from the cited art.

For example, Examiner avers that Primis teaches:

"identifying a plurality of topics based on chapter and section headings in the documentation, wherein each said topic is associated with a portion of the documentation" (see Office Action page 2-3).

Applicant respectfully points out Primis teaches only a system wherein users select material from a library and manually assemble the material into an "e-book." For example, a professor can create custom textbooks from McGraw-Hill content and their partners content (see McGraw-Hill "eBooks in Higher Education: What We Have Learned... Where are we going?," page 2, hereinafter "McGraw-Hill"). The custom textbook created by the professor is then made commercially available to students using the MHHE website (see McGraw-Hill, page 6-7). Hence, Primis is essentially a web-based utility which allows a user to virtually "cut-and-paste" sections from a library of documents in order to create a larger document (an "e-book"). Nothing within Primis suggests a system that

parses or organizes the topics within the electronic documents. Consequently, nothing within Primis suggests identifying a series of topics based on chapter and section headings, or associating a portion of the parsed electronic documents with each identified topic.

On the other hand, one embodiment of the present invention takes as input series of documents in any of a number of document formats (see page 6, page 9, and FIG. 1B of the instant application). From entities such as titles, headings, illustration captions within the series of documents, and other document features, the system creates a list of topics that may be used to organize a virtual book (see page 6 and FIG. 2 element 206 of the instant application). While generating the list of topics, the system associates portions of the series of documents with the topic (see page 13 of the instant application). At the end of this process the system has a series of topics and a list of document portions associated with each topic which the system can then use to compose a virtual book based on a user request. Hence, identifying topics and associating portions of the series of documents with the topics is beneficial because later steps of the process use the identified topics and associated information during the automated composition of the virtual book.

Applicant respectfully points out that the remaining arguments posited by Examiner encounter the same issues. For example, examiner argues that the system taught in Primis teaches:

“classifying each of said topics into one or more categories” and
“receiving a subject for a virtual book” (see Office Action page 3).

Applicant again respectfully points out that Primis is essentially a web-based utility which allows a user to virtually “cut-and-paste” sections from a library of documents in order to create a larger document (an “e-book”). Nothing within Primis suggests a system that parses or organizes the topics within the electronic documents. Consequently, nothing within Primis suggests classifying topics

identified by the system into one or more categories or receiving a subject for a virtual book.

On the other hand, one embodiment of the present invention classifies the material associated with the identified topics in one of a series of categories (see page 18 and FIG.2 element 214 of the instant application). For example, the material in a particular topic may fit under a “concept” classification, where the concept classification is reserved for material that is best suited for a novice reader (see page 8 of the instant application). When the system subsequently composes a virtual book for a novice user, the system uses the category to assure that the material in the virtual book meets that user’s needs. The classification is beneficial because system can compose the classified material into a virtual book appropriate for the user who requests it.

Furthermore, the one embodiment of the present invention receives a request for documentation from a user. Upon receiving the request, the system composes a virtual book specifically tailored to the user based on the subject that the user requested and the characteristics of the user (see page 10, page 18, and Fig. 2, elements 216 and 218 of the instant application). With a specifically tailored virtual book, the user avoids the need to perform a manual and error-prone search through multiple sources for information. In addition, if the user has a question that the virtual book does not properly answer, the user need only slightly change the request and the system can generate another virtual book based on the new request. Hence, receiving a request is beneficial because it allows the system to create virtual books based on the particular subject matter requested by the user.


Hence, Applicant respectfully submits that independent claims 1, 14, 15, and 17 are in condition for allowance. Applicant also submits that claims 2-13, which depend upon claim 1, and claims 18-21, which depend upon claim 17, are for the same reasons in condition for allowance and for reasons of the unique

combinations recited in such claims. Claim 16 was previously cancelled without prejudice.

CONCLUSION

It is submitted that the present application is presently in form for allowance. Such action is respectfully requested.

Respectfully submitted,

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